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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,389	06/28/2001	Michael Epstein	US 010313	6444

24737 7590 12/06/2005

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EXAMINER

ZAND, KAMBIZ

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,389

Applicant(s)

EPSTEIN, MICHAEL

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/08/2005 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

3. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

4. Claim 1 has been cancelled.

5. Claims 2, 5-7, 11-13, 16-17, 21 and 22 have been amended.

6. Claims 2-22 are pending.

Response to Arguments

7. Applicant's arguments filed 10/03/2005 and amendment filed on 11/08/2005 have been fully considered but they are not persuasive.

- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. "receives the protected material undamaged"; "distributing the software 'undamaged' "; and end user's computer includes means for generating damaged version and repairing the damaged version on pages 10 and 11 of applicant's response filed on 10/03/2005) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- Also the amendment claims only disclose "receiving the material from a remote source" or the arguments with respect to plurality of apparatus verses a single apparatus do not change the fact that Evans teaches such a process (see below). **However such a change is a design choice/intended use and not a novelty or an inventive step (A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).)**

Claim Rejections - 35 USC § 103

8. **Claims 2-22** are rejected under 35 U.S.C. 103(a) as being anticipated by Evans et al (WO 01/01316 A2) recited in applicant's IDS filed on 11/22/2002.

As per claims 12 and 22 Evans et al (WO 01/01316 A2) teach an apparatus, method for receiving, protecting and storing material, said apparatus, method (see title on page 1; line 1 on page 5) comprising: receiving/means for receiving material in an unprotected form from a remote source (see page 24, lines 25-30), and generating a damaged version of the material and store a damaged version of the material while determining the authorization (see page 24, lines 25-30 or fig.8, block 806; page 5, lines 3-10 where examiner considers the encrypted software as damaged content since without the decryption key is not usable; and wherein the generation of the damaged version of applicant's corresponds to encryption generation of the software; fig.4 and associated text; see fig.8 block 808 where the verifier accept the payment and sending the decryption key for the protected material; examiner considers the accepting of the payment as determination of authorization and sending the decrypted key as authorization for processing the protected material), and repair the damaged version of the material to form a repaired version of the material after the verifier determines the authorization (the repair is being done by decrypting the encrypted content as disclosed on page 5, lines 3-25). Also see the entire reference for different variation of content protections under the same analogy that is providing a damage content (encrypted, scrambled, watermarked, etc.) to the client (user, client, server, entity, etc) and upon authorization (user authorization, payment authorization, license verification, etc.) repair the damage content by a decrypting key or descrambler key, etc.. to a usable content and where the downloading of the content or storing of the protected content is being done while

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the authorization is in process or before that process. Although Evans not clearly discloses that the receiving apparatus is the one apparatus that damage and repair the received material, however Evans as is teaching such a process disclosed above. It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Evan's encryption and decryption of the received material within the receiving system in order to reduce the processing time and the cost related to using the plurality of the services as a desired design choice where such intended use have been disclosed as above (**A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).**

As per claims 2 and 13 Evans et al (WO 01/01316 A2) teach the apparatus and the method of claims 22 and 12, wherein the verifier determines the authorization based on a verification of a presence of an entirety of a data set corresponding to the material (see page 5, lines 1-24; page 20, lines 8-12 and page 10, lines 10-14).

As per claims 5 and 16 Evans et al (WO 01/01316 A2) teach the apparatus and the method of claims 22 and 12, wherein the gate comprises: damaging means damages a select portion of the material to form the damaged version, and the repairing means repairs a corresponding select portion of the damaged version to

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form the repaired version (see fig.8 and page 1-5 where examiner considers the encrypted key corresponding to Applicant's damager; where encrypted content corresponds to Applicant's damage content; where decryption key corresponds to Applicant's repairer and where the decryption version corresponds to Applicant's undamaged or repaired content).

As per claim 6 Evans et al (WO 01/01316 A2) teach the apparatus of claims 5, wherein the apparatus further comprises: means for disabling the damaging means in order to prevent subsequent damage to the material, after the verifier determines the authorization (see page 5; fig.8 where after determining the authorization such as payment acceptance by providing the decryption key for decrypting the encrypted software or content the act of disabling of the encrypted process is being done where the examiner considered the encrypted process as a damage process of content as applied to claim 22 above).

As per claims 11 and 21 Evans et al (WO 01/01316 A2) teach the apparatus and the method of claims 22 and 12, wherein said apparatus further comprises: means for rendering the material while the verifier is determining the authorization (see fig.8 and associated text).

9. **Claims 3-4 and 14-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Boebert et al (5,502,766).

As per claims 3 and 14 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 22 and 12, but do not disclose explicitly the gate is further storing means stores the damaged version on a removable media. However Boebert et al (5,502,766) disclose storing the damaged version on a removable media (see abstract; fig.3 and associated text). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ebert's removable medium in evan's software distribution system and method in order to provide a data enclave for securing data carried on a removable storage units (see col.5, lines 39-43).

As per claims 4 and 15 Evans et al (WO 01/01316 A2) teach the security system and the method of claims 22 and 12, wherein store the damaged version, and store the repaired version in a permanent storage device as applied to claim 22 and 12 above but do not disclose storing the damaged version in a temporary storage device. However Ebert et al (5,502,766) disclose storing the damaged version in a temporary storage device (see fig.3 and associated text). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ebert's removable medium in evan's software distribution system and method in order to provide a data enclave for securing data carried on a removable storage units (see col.5, lines 39-43).

10. **Claims 7-10 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004.

As per claims 7 and 17 Evans et al (WO 01/01316 A2) teach all limitations of the claim as applied above but do not explicitly disclose a first device damage the select portion of the material via an exclusive--or function with a key, and the repairer includes: a second device that is configured to repair the select portion of the material via an exclusive--or function with the key. However Kubota (5,034,980) disclose a first device that is configured to damage the select portion of the material via an exclusive--or function with a key, and the repairer includes: a second device that is configured to repair the select portion of the material via an exclusive--or function with the key (see col.4, lines 46-66). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Kubota's XOR ciphering in Evan's software distribution system and method in order to implement simplest forms of coding (see col4, page 66-67).

11. **Claims 8-9 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004, and further in view of Boebert et al (5,502,766).

As per claims 8-9 and 18-19 Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) teach all limitations of the claim as applied above but do not explicitly disclose each the apparatus and the method of claims 7 and 17, wherein the key is provided via a random process and the key includes a series of random numbers that are provided via a pseudo-random process based on a key-seed. However Ebert et al (5,502,766) disclose the key is provided via a random process and the key includes a series of random numbers that are provided via a pseudo-random process based on a key-seed (see col.26, lines 43-55). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ebert's random number key generation process in Kubota's XOR ciphering in Evan's software distribution system and method in order to implement more robust forms of coding.

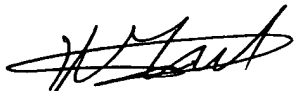
12. **Claims 10 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) as recited in the Applicant's IDS filed on 11/22/2004, and further in view of Hogg et al (4,281,216).

As per claims 10 and 20 Evans et al (WO 01/01316 A2) in view of Kubota (5,034,980) teach *the apparatus* and the method of claims 7 and 17 as applied above but do not disclose explicitly wherein the key is destroyed if the verifier fails to determine the authorization. However hog et al (4,281,216) disclose the key is destroyed if the verifier fails to determine the authorization (see col.12, lines 27-33). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Hogg's

key destruction in case of unauthorized attempt in Kubota's XOR ciphering in view of Evan's software distribution system and method in order to prevent unauthorized access to the content.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

12/03/2005

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